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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,812	06/07/2005	Markus Egerter	028987.55877US	5467
23911	7590	03/05/2007	EXAMINER	
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/537,812	EGERTER ET AL.	
Examiner	<b>Art Unit</b>		
Vinh T. Luong	3682		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 18 January 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 13-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 13-32 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 07 June 2005 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

d. 

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/7/05.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: *Attachments 1 and 2.*

1. The preliminary amendment and the substitute specification filed on June 7, 2005 have been entered.
2. The drawings are objected to because of the reasons, e.g., listed below:

(a) The drawings are not consistent with the written disclosure. For example, paragraph [0024] of the specification describes the plastic shaft part 6 and the thermoplastic synthetic enveloping body 22. However, FIG. 3 does not show the plastic and thermoplastic synthetic materials in accordance with the drawing symbols for draftsperson in MPEP 608.02. Applicant is respectfully urged to use the drawing symbols approved by American National Standards Institute. See MPEP 608.02; and

(b) Each part of the invention, such as, e.g., the mold in paragraph [0028] of the specification and claims 24 and 32 should be designated by a reference character.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, (a) the plastic basic body and the thermoplastic enveloping body in claims 17, 26, and 27; and (b) the mold in claims 24 and 32 must be shown or the features canceled from the claims. *No new matter should be entered.*

FIG. 3 does not show the plastic and thermoplastic synthetic materials in accordance with the drawing symbols for draftsperson in MPEP 608.02. In addition, FIG. 3 shows the molding 28 but not the mold held at a distance from the basic body 2 that sprays out the plastic.

4. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of the objections above. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

5. The information disclosure statement filed June 7, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant stated: “[c]opies of references AA-AE listed on the attached form PTO-1449 have already been provided by the International Searching Authority and, therefore, duplicate copies are not attached hereto.” However, the International Searching Authority has not provided the copies of references AA-AE. See MPEP 609.03. In this case, the Examiner has considered the references AA and AB since they are US Patent documents. Further, reference AE has a patent family member US Patent No. 6,168,343 based on International Search Report. Therefore, reference AE has been considered also.

6. The disclosure is objected to because of the following informalities:

(a) The specification and the claims are not consistent with the drawings. For example, paragraph [0024] of the specification describes the plastic shaft part 6 and the thermoplastic synthetic enveloping body 22. However, FIG. 3 does not show the plastic and thermoplastic synthetic materials in accordance with the drawing symbols for draftsperson in MPEP 608.02; and

(b) Each part of the invention, such as, e.g., the mold in paragraph [0028] of the specification and claims 24 and 32 should be designated by a reference character.

Appropriate correction is required.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 13-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear:

(a) Which structure is the lining in claim 13. Applicant is respectfully urged to identify each claimed element with reference to the drawings; and

(b) Whether a confusing variety of terms, such as, "a lining" in claim 13 and "an elastically constructed enveloping body" in claim 14 refer to the same or different things. See MPEP 608.01(o) and double inclusion in MPEP 2173.05(o). Similar problem is seen for the terms "a knob body" in claim 13 and "a basic body" in claim 14. Applicant is respectfully urged to identify each claimed element with reference to the drawings.

The terms such as "flexible" and "can be fastened" in claim 1 are vague and indefinite in the sense that things, which may be done, are not required to be done. For example, the knob can be *but is not structurally required to be* fastened on the control lever. See "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), "crimpable" in *Application of Collier*, 158 USPQ 266 (CCPA 1968), "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

The term "hard" in claim 17, 26, and 27 is a relative term, which renders the claim indefinite. The term "hard" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear, e.g., what range of hardness of the plastic material is required in order to be considered as "a hard plastic material."

The term "window-type recesses" in claims 16 and 25 is indefinite since it is unclear, e.g., what geometric shapes of the recesses are the window-type recesses.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 13-15, 17-19, 24, 26, 28, 29, and 32, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Foggini'718 (US Patent No. 4,724,718 cited by Applicant).

Regarding claim 13, Foggini'718 teaches a knob or grip end 10 for a control lever A of a motor vehicle, comprising: a knob body 12 which has a receiving device 14 for the control lever A, and a lining 11 made of a flexible material, by which the knob 10 can be fastened on the control lever A.

Regarding claim 14, the knob body 12 has a basic body 12b with a shaft part (see Attachment 1 hereinafter “Att. 1”) and a head part (Att. 1) which are surrounded at least partially by an elastically constructed enveloping body 12a, 11 and wherein openings 14b are provided in a lateral surface of the shaft part (Att. 1) and are penetrated by sections of the enveloping body 12a, 11. *Ibid.* col. 2, lines 25-66 and claims 1-8.

Regarding claim 15, the openings 14b extend in axial and circumferential directions of the shaft part (Att. 1).

Regarding claims 17 and 26, the basic body 12b is of a hard plastic material and the enveloping body 12a, 11 is of an elastic thermoplastic synthetic material or polyurethane.

Regarding claims 18 and 28, a detent device for axially fixing the knob 10 on the control lever A is provided in the head part (Att. 1) of the basic body 12b.

Regarding claims 19 and 29, the detent device has several snap hooks 14a which engage in recesses T provided at the control lever A.

Regarding claims 24 and 32, the patentability of a product-by-process claim does not depend on its method of production. See MPEP 2113.

11. Claims 13-17, 21-27, 31, and 32, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Foggini'490 (US Patent No. 4,807,490).

Regarding claim 13, Foggini'490 teaches a knob or grip end 10 for a control lever 20 (Figs. 3-7) of a motor vehicle, comprising: a knob body 12 which has a receiving device 154 (Attachment 2 hereinafter "Att. 2") for the control lever 20, and a lining 11 made of a flexible material, by which the knob 10 can be fastened on the control lever 20. *Ibid.* col. 2, line 63 through col. 3, line 15 and claim 1.

Regarding claim 14, the knob body 12 has a basic body 150, 151 with a shaft part (Att. 2) and a head part (Att. 2) which are surrounded at least partially by an elastically constructed enveloping body 11 and wherein openings 152 (FIG. 4) are provided in a lateral surface of the shaft part (Att. 2) and are penetrated by sections of the enveloping body 11.

Regarding claim 15, the openings 152 extend in axial and circumferential directions of the shaft part (Att. 2).

Regarding claims 16 and 25, the openings 152 are constructed as window-type recesses 152, and the sections of the enveloping body 11 engaging in the recesses 152 forms ribs 120 (Fig. 6).

Regarding claims 17, 26, and 27, the basic body 150, 151 is of a hard plastic material and the enveloping body 11 is of an elastic thermoplastic synthetic material or polyurethane.

Regarding claims 21 and 31, outer ribs 120 extending from the shaft part (Att. 2) to the head part (Att. 2) are provided for anchoring the enveloping body 11.

Regarding claims 22 and 23, referring the knob to the merely inferentially included or intended use element such as the control lever is not accorded patentable weight. On the other hand, Foggini'490's knob is capable of being fastened on the control lever that is flattened on both sides due to the elasticity of plastic materials. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then, it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

Regarding claims 24 and 32, the patentability of a product-by-process claim does not depend on its method of production. See MPEP 2113.

12. Claims 20 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Konig et al. (enveloping body 34), Sennette et al. (detent 56), and Kikuchi et al. (enveloping body 2).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley, can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

March 1, 2007



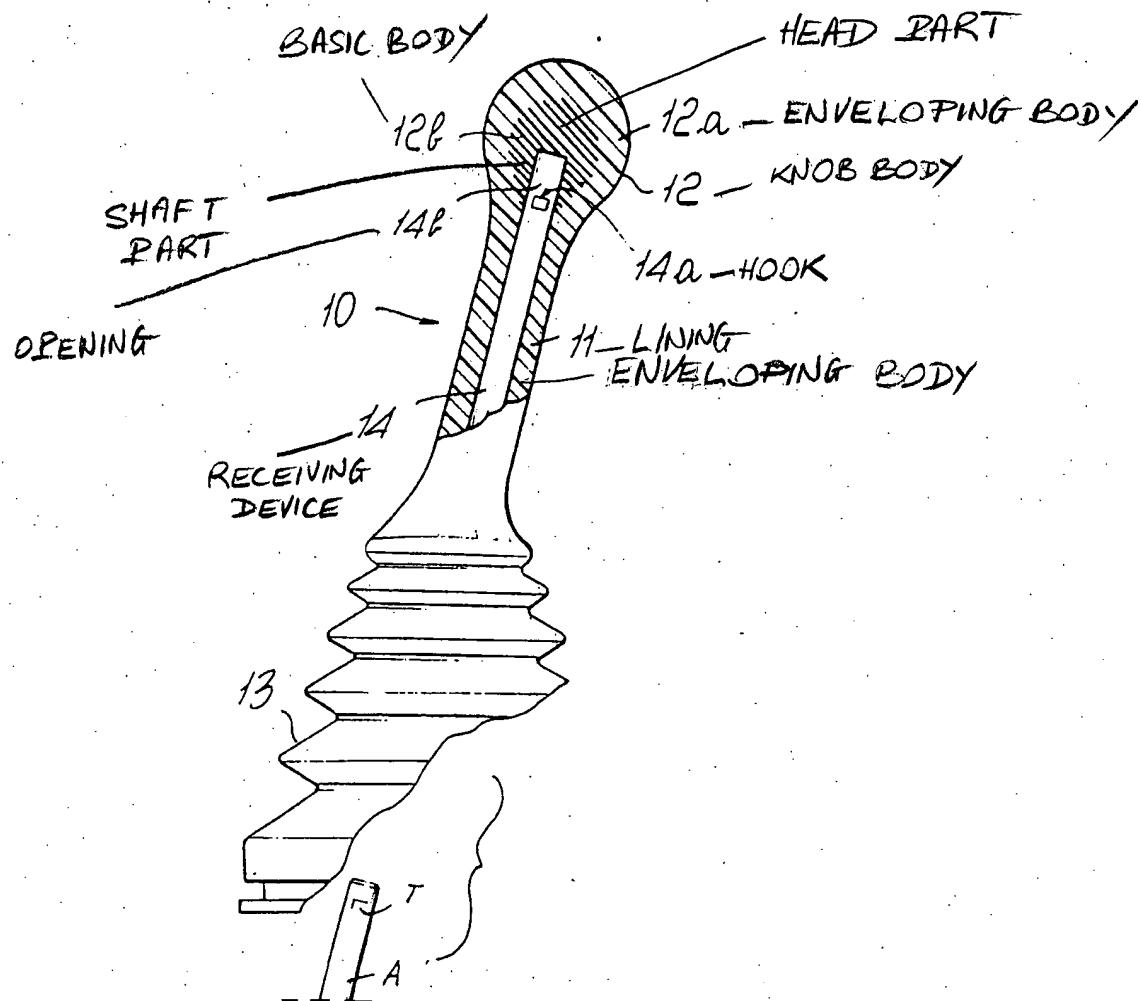
Vinh T. Luong  
Primary Examiner

# **ATTACHMENT 1**

U.S. Patent

Feb. 16, 1988

4,724,718



## **ATTACHMENT 2**

U.S. Patent

Feb. 28, 1989

Sheet 2 of 2

4,807,490

